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10/550,368	06/30/2006	Stuart Taylor	E1844-00007	7984
833 750 020602008 DUANE MORRIS, LLP IP DEPARTMENT 30 SOUTH 17TH STREET PHILADELPHIA. PA 19103-4196			EXAMINER	
			HUSSAIN, IMAD	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Application No. Applicant(s) 10/550,368 TAYLOR ET AL. Office Action Summary Examiner Art Unit IMAD HUSSAIN 4117 -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS. WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). Status 1) Responsive to communication(s) filed on 02 March 2007. 2a) This action is FINAL. 2b) This action is non-final. 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Claims 4) Claim(s) 1-53 is/are pending in the application. 4a) Of the above claim(s) _____ is/are withdrawn from consideration. 5) Claim(s) _____ is/are allowed. 6) Claim(s) 1-53 is/are rejected. 7) Claim(s) _____ is/are objected to. 8) Claim(s) _____ are subject to restriction and/or election requirement. Application Papers 9) The specification is objected to by the Examiner. 10) ☐ The drawing(s) filed on 19 September 2005 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No. 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

Paper No(s)/Mail Date 19 December 2005.

Interview Summary (PTO-413)
 Paper No(s)/Mail Date.

6) Other:

Notice of Informal Patent Application

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DETAILED ACTION

1. Claims 1-53 are pending in application 10/550,368.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35
 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No.
 PCT/GB2004001218. filed on 22 March 2004.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

 Claim 28 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In this case, computer-related inventions whether descriptive or functionally descriptive material are non-statutory categories when claimed as descriptive material per se (see Warmerdam, 33 F.3d at 1360 USPQ2d at 1759), falling under the "process" category (i.e. inventions at that consist of a series of steps or acts to be performed). See 35 U.S.C. 100(b) ("The term process means, art, or method, and includes a new of a known process, machine, manufacture, composition of matter or material"). Functional descriptive material: "data structures" representing descriptive material per se or computer program representing computer listing per se (i.e. software per se) when embodied in a computer-readable media are still not statutory because they are not

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capable of causing functional change in the computer. However, a claimed computerreadable storage medium encoded with a data structure, computer listing or computer program, having defined structural and functional interrelationships between the data structure, computer listing or computer program and the computer software and hardware component, which permit the data structure's, listing or program's functionality to be realized, is statutory (see MPEP 2106). Claim 28 is directed toward a computer program and is hence non-statutory, as described above.

Claim Rejections - 35 USC § 103

- The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- Claims 1-5, 12, 18, 25-27, 42 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takashi Morikawa (US 5613108 A, hereinafter Morikawa) in view of Juergen Stark et al. (US 7062535 B1, hereinafter Stark).

Regarding claim 1, Morikawa teaches a method of filing a received e-mail message [Morikawa: Column 2 Lines 29-37 and Figure 6], the method comprising:

-reading data [Morikawa: "attachment"] within the received e-mail message [Morikawa: Column 2 Lines 44-45];

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-comparing the data to a plurality of pre-stored text-based data [Morikawa:

"attributes" Column 2 Lines 60-64]; and

-storing data content of at least a part of the received e-mail message in a selected data folder to which the data corresponds [Morikawa: Column 2 Lines 47-48],

-the method requiring no external access to data to carry out the reading, comparing and storing [Morikawa's technique does not state any requirement for external access to data].

Morikawa does not explicitly disclose that the data is a self-describing text-based data structure within a text body.

However, Stark discloses a self-describing text-based data structure for structured text-based e-mail bodies [Stark: "MessageML" XML-formatted "SmartMessages", Column 2 Lines 29-31 and 39-40].

Morikawa and Stark are analogous art in the same field of endeavor as both cover the automatic management of received e-mail messages. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the e-mail filing method of Morikawa with the MessageML data structures of Stark. One of ordinary skill in the art would have been motivated to modify the method of Morikawa with the MessageML data structures of Stark because in doing so, the method would allow for synthesizing the data from multiple messages without the user being required to read the contents of each message [Stark: Column 2 Lines 8-13].

Regarding claim 2, Morikawa-Stark teaches:

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-creating a new data folder if the self-describing text-based data structure does not correspond to any of the plurality of pre-stored text-based data structures [Morikawa: "attributes", Column 9 Lines 16-18]; and

-the storing step data content comprises storing at least a part of the received email message [Morikawa: "attachment"] in the new data folder [Morikawa: Column 2 Lines 47-48].

Regarding claim 3, Morikawa-Stark teaches:

-adding the self-describing text-based structure to the plurality of pre-stored textbased data structures [Morikawa: "the folder name is entered in the table folder in combination with the file attribute information", Column 9 Lines 18-20]; and

 -associating the self-describing text-based structure with the new folder [Morikawa: Column 9 Lines 18-20].

Regarding claim 4, Morikawa-Stark teaches that the self-describing text-based data structure further comprises:

- -a plurality of data sets [Morikawa: "attachment files AF", Column 8 Lines 17-18];
 and
 - -the storing step data content further comprises:
- -storing each set of the plurality of data sets as a record that can be separately manipulated in a selected folder [Morikawa: Column 8 Lines 17-24].

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Regarding claim 5, Morikawa-Stark teaches that the self-describing text-based structure

causes an interaction action to occur with previously received or existing data [Stark:

Column 6 Lines 1-4 "SmartMessages 10 contain standardized XML-tags that enable the

platform to understand the nature of the message and... consolidate... the

communication accordingly" and Figure 3C "consolidate and send weekly summary" of

messages].

Regarding claim 12, Morikawa-Stark teaches:

-using the self-describing text-based data structure to create a new definition for

a folder [Morikawa: Column 9 Lines 18-20, "attribute"]; and

-applying that new definition to a new folder [Morikawa: Column 9 Lines 18-20].

Regarding claim 18, Morikawa-Stark teaches that the self-describing text-based data

structure further comprises:

-a processing command for controlling any aspect of the method [Stark: Column

6 Lines 1-4].

Regarding claim 25, Morikawa-Stark teaches that the self-describing text-based data

structure further comprises:

-a data structure written in a command language [Stark: "MessageML" XML-

formatted "SmartMessages", Column 2 Lines 29-31 and 39-40].

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Regarding claim 26, Morikawa-Stark teaches that the self-describing text-based data structure further comprises:

-an XML schema [Stark: "MessageML" XML-formatted "SmartMessages", Column 2 Lines 29-31 and 39-40]: and

-the received e-mail message further comprises:

-data conforming to the XML schema [Stark: "MessageML" XML-formatted "SmartMessages", Column 2 Lines 29-31 and 39-40].

Regarding claim 27, the claim comprises substantially the same limitations as claim 1. The same rationale for rejection is applicable.

Regarding claim 42, the claim comprises substantially the same limitations as claim 1 with the addition of instant messaging as a communication medium as taught by Stark [Stark: Column 11 Lines 1-3]. The same rationale of rejection is applicable.

Regarding claim 45, the claim comprises substantially the same limitations as claim 3. The same rationale of rejection is applicable.

Claims 6-11, 28-41, 43-44, 46-47, 49 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morikawa and Stark as applied to claim 5 above in further view of Julio Estrada (US 2003/0135565 A1, hereinafter Estrada).

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Regarding claim 6, Morikawa-Stark teaches that the interaction action comprises storing data content of at least a significant part of the received e-mail message [Morikawa: "attachment"] in a selected data folder to which the self-describing text-based data structure corresponds [Morikawa: Column 2 Lines 47-48].

Morikawa-Stark does not explicitly disclose overwriting a data set of a text-based data structure previously stored within the folder with a data set of the self-describing text-based data structure.

However, Estrada teaches a method by which XML-tagged electronic mail messages replace previously stored folder data with new data [Estrada: Paragraph 0030].

Morikawa-Stark and Estrada are analogous art in the same field of endeavor as both cover the automatic management of received e-mail messages. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the e-mail filing method of Morikawa-Stark with the collaboration system of Estrada for e-mail based folder synchronization. One of ordinary skill in the art would have been motivated to modify the method of Morikawa-Stark with the collaboration system of Estrada because in doing so, the method would aid efficiency by removing the need to switch between applications for e-mail and project collaboration [Estrada: Paragraph 0008].

Regarding claim 7, Morikawa-Stark-Estrada teaches that the received e-mail specifies matching data and certain fields of data structure [Estrada: Paragraph 0051 "part

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comprising information to... identify the collaborative workspace to which the message relates". and the interaction action further comprises:

-comparing the matching data for certain fields of a previously stored data set [Estrada: Paragraph 0052 uses aforementioned information part to "place the message in the intended collaborative workspace folder", inherently comparing matching data];

-interacting with the data set where data stored in the certain fields matches the matching data [Estrada: Paragraph 0030].

Regarding claim 8, Morikawa-Stark-Estrada teaches that the interacting step with the data set further comprises:

-updating the data set where the data stored in the certain fields matches the matching data [Estrada: Paragraph 0030].

Regarding claim 9, Morikawa-Stark-Estrada teaches that updating the data set further comprises:

-deleting the data set [Estrada: Paragraph 0131 "Delete Message/File"].

Regarding claim 10, Morikawa-Stark-Estrada teaches that updating the data set further comprises:

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-inserting a data set provided in the received e-mail in place of a deleted data set [Estrada: Paragraph 0030 teaches replacing previous data with changed data from the received e-mail].

Regarding claim 11, Morikawa-Stark-Estrada teaches that storing data content of at least a significant part of the received e-mail message further comprises:

-overwriting [Estrada: Paragraph 0030 teaches replacing previous data with changed data from the received e-mail] a text-based data structure [Stark: "MessageML" XML-formatted "SmartMessages", Column 2 Lines 29-31 and 39-40] previously stored within the selected data folder with the self-describing text-based data structure.

Regarding claim 28, Morikawa-Stark-Estrada teach that the means comprise an e-mail application and a plug-in [Estrada: Paragraph 0009].

Regarding claim 29, the claim comprises substantially the same limitations as claim 7.

The same rationale for rejection is applicable.

Regarding claim 30, Morikawa-Stark-Estrada teaches that the interaction is determined by the text-based data structure [Stark: Figure 3C].

Regarding claim 31, Morikawa-Stark-Estrada teaches:

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-a data payload conforming to the text-based data structure [Stark: "MessageML" XML-formatted "SmartMessages". Column 2 Lines 29-31 and 39-401: and

-further wherein the interaction is between at least the pre-stored data and the data payload [Stark: Column 6 Lines 1-4 "SmartMessages 10 contain standardized XML-tags that enable the platform to understand the nature of the message and... consolidate... the communication accordingly" and Figure 3C "consolidate and send weekly summary" of messages].

Regarding claim 32, the claim comprises substantially the same limitations as claims 29 and 11. The same rationale for rejection is applicable.

Regarding claim 33, the claim comprises substantially the same limitations as claims 31 and 9. The same rationale for rejection is applicable.

Regarding claim 34, the claim comprises substantially the same limitations as claims 28 and 30. The same rationale for rejection is applicable.

Regarding claim 35, the claim comprises substantially the same limitations as claim 6 with the additional limitation of *a processing instruction to effect control*, as taught by Stark [Figure 3C]. The same rationale for rejection is applicable.

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Regarding claim 36, Morikawa-Stark-Estrada teaches updating a sender-defined database on a recipient's computer [Stark: Figure 3C updating the sender-defined local store on a recipient's computer and Estrada: Abstract, updating a sender-defined project workspace on a recipient's computer].

Regarding claim 37, Morikawa-Stark-Estrada teaches that updating the pre-stored data in accordance with the text-based processing instruction to effect control further comprises updating a functional capability of a recipient's program [Estrada: Abstract and Figure 5, updating the files on a recipient's computer, including files of different types (including executable program files)].

Regarding claim 38, Morikawa-Stark-Estrada teaches updating the pre-stored data in accordance with the text-based processing instruction to effect control further comprises updating the executable code of a program provided at a recipient [Estrada: Abstract and Figure 5, updating the files on a recipient's computer, including files of different types (including executable program files)].

Regarding claim 39, Morikawa-Stark-Estrada teaches updating the pre-stored data in accordance with the text-based processing instruction to effect control further comprises issuing commands to a program provided at a recipient [Estrada: Paragraph 0131 "Delete Message/File" is a command executed by the recipient e-mail program].

Regarding claim 40, Morikawa-Stark-Estrada teaches updating the pre-stored data in accordance with the text-based processing instruction to effect control further comprises issuing commands indirectly to other programs [Estrada: Paragraph 0131 "Delete Message/File" inherently involves a function all to the underlying operating system program].

Regarding claim 41, the claim comprises substantially the same limitations as claim 37 and claim 28 (where the reading, accessing, and updating means are the program and modules as taught by Estrada). The same rationale of rejection is applicable.

Regarding claim 43, the claim comprises substantially the same limitations as claims 35 and 42. The same rationale of rejection is applicable.

Regarding claim 44, the claim comprises substantially the same limitations as claims 42 and 7. The same rationale of rejection is applicable.

Regarding claim 46, the claim comprises substantially the same limitations as claim 7. The same rationale for rejection is applicable.

Regarding claim 47, the claim comprises substantially the same limitations as claim 6.

The same rationale for rejection is applicable.

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Regarding claim 49, the claim comprises substantially the same limitations as claim 36.

The same rationale for rejection is applicable.

Regarding claim 53, the claim comprises substantially the same limitations as claim 32. The same rationale for rejection is applicable.

8. Claim 13 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morikawa and Stark as applied to claim 12 above in view of Richard Segal et al. (MailCat: An Intelligent Assistant for Organizing E-Mail. hereinafter Segal).

Regarding claim 13, Morikawa-Stark does not explicitly disclose:

-updating a definition of an existing data folder with a new folder definition if the self-describing text-based data structure does not correspond to any of the plurality of pre-stored text-based data structures and an identifier of the self-describing text-based data structure matches that of the existing data folder.

However, Segal teaches a method of updating a classifier for an existing data folder with a new classifier if the text data of the message does not correspond directly to the pre-stored text data ["word-frequency vector"] and the message is matched to the existing data folder [Segal: Page 278 "MailCat adapts to changing... entire mail database" paragraph].

Morikawa-Stark and Segal are analogous art in the same field of endeavor as both cover the automatic management of received e-mail messages. It would have

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been obvious to one of ordinary skill in the art at the time the invention was made to modify the e-mail filing method of Morikawa-Stark with the training system of Segal for automatic categorization updating. One of ordinary skill in the art would have been motivated to modify the method of Morikawa-Stark with the training system of Segal because in doing so, the method would greatly simplify user interaction without need for explicit instructions [Segal Page 277 last paragraph].

Regarding claim 48, the claim comprises substantially the same limitations as claim 13. The same rationale for rejection is applicable.

 Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morikawa and Stark as applied to claim 1 above in view of Yoshio Sugimoto (US 2002/0002588 A1, hereinafter Sugimoto).

Regarding claim 14, Morikawa-Stark does not explicitly disclose that the *storing data* content of at least a significant part of the received e-mail message further comprises:

- -storing received data in a database; and
- -the method further comprises:
- -using database data handling techniques to manipulate at least part of the received data.

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However, Sugimoto discloses a means of storing e-mail message data in a database [Sugimoto: Paragraph 0010 and 0058] and using database techniques to manipulate the received data [Sugimoto: Paragraph 0060].

Morikawa-Stark and Sugimoto are analogous art in the same field of endeavor as both cover the automatic management of received e-mail messages. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the e-mail filing method of Morikawa-Stark with the database system of Sugimoto for e-mail data storage. One of ordinary skill in the art would have been motivated to modify the method of Morikawa-Stark with the database system of Sugimoto because in doing so, the method would allow for the use of standard database languages and methods [Sugimoto: Paragraphs 0021 and 0060].

Regarding claim 15, Morikawa-Stark-Sugimoto teaches sorting contents of the selected data folder according to a user-selected characteristic [Sugimoto: Paragraph 0066].

Regarding claim 16, Morikawa-Stark-Sugimoto teaches:

 -writing the self-describing text-based data structure to a database file external to an e-mail function by which the self-describing text-based data structure was received [Sugimoto: Paragraph 0010].

Regarding claim 17, Morikawa-Stark-Sugimoto teaches that the self-describing textbased data structure further comprises:

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 -a processing command for controlling an application which has access to the database file [Stark: Column 6 Lines 1-4].

10. Claims 19-24 and 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morikawa and Stark as applied to claim 1 above in view of John Ogilvie et al. (US 6324569 B1, hereinafter Ogilvie).

Regarding claim 19, Morikawa-Stark do not explicitly disclose that at least a portion of the self-describing text-based data structure is encoded and the method further comprises:

-decoding the portion of the self-describing text-based data structure before comparing step the self-describing text-based data structure to a plurality of pre-stored text-based data structures.

However, Ogilvie teaches that e-mail may be encrypted and later decrypted before being processed [Ogilvie: Column 2 Lines 46-49].

Morikawa-Stark and Ogilvie are analogous art are analogous art in the same field of endeavor as both cover the automatic management of received e-mail messages. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the e-mail filing method of Morikawa-Stark with the self-deleting e-mail of Ogilvie for removing old e-mail. One of ordinary skill in the art would have been motivated to modify the method of Morikawa-Stark with the self-deleting e-mail system

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of Ogilvie because in doing so, the method would allow for alleviating the burden of removing unsolicited and older messages [Ogilvie: Abstract].

Regarding claim 20, Morikawa-Stark-Ogilvie teach that the received e-mail message contains an encrypted license from a sender authenticating the sender [Ogilvie: Column 12 Lines 1-8 "key, certificate, password, or other authentication mechanism"].

Regarding claim 21, Morikawa-Stark-Ogilvie teach that the encrypted license ["authentication mechanism"] further comprises:

-the self-describing text-based data structure [Stark: "MessageML" XML-formatted "SmartMessages", Column 2 Lines 29-31 and 39-40].

Regarding claim 22, Morikawa-Stark-Ogilvie teach:

-comparing a current date with a date of receipt of a previously filed e-mail, and removing the previously filed e-mail if a time period between the current date and the date of receipt of a previously filed e-mail exceeds a predetermined amount [Ogilvie: Column 6 Lines 14-19 and Lines 43-49].

Regarding claim 23, Morikawa-Stark-Ogilvie teach that the received e-mail message further comprises:

 an expiry time, the expiry time lapsing when the expiry time exceeds the predetermined amount, and the removing step comprises removing the previously filed e mail if the expiry time has lapsed [Ogilvie: Column 6 Lines 14-19 and Column 12 Lines 54-60].

Regarding claim 24, Morikawa-Stark-Ogilvie teach that the received e-mail further comprises:

-a deletion instruction, wherein the a current date with a date of receipt of a previously filed e-mail, and the removing the previously filed e-mail if a time period between the current date and the date of receipt of a previously filed e-mail exceeds a predetermined amount are carried out on reading of the deletion instruction [Ogilvie: Column 6 Lines 14-19 and Column 12 Lines 54-60].

Regarding claims 50 and 51, the claims recite substantially the same limitations as claim 20. The same rationale of rejection is applicable.

Regarding claim 52, the claim comprises substantially the same limitations as claim 22. The same rationale of rejection is applicable.

Citation of pertinent prior art

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Apparatus for processing communications US 7007067 B1
 Azvine: Benham et al.

- Methods and systems for linking an electronic address to a physical address of a customer US 20020059381 A1 Cook, Jon L. et al.
- c. System and method for managing electronic mail messages using a clientbased database US 6134582 A Kennedy; Kevin Alan
- d. Virtual document organizer system and methodUS 20020120627 A1
 Mankoff, Jeffrey W.
- e. Methods and systems for electronic mail, internet target and direct marketing, and electronic mail banner US 20020188689 A1 Michael, Chung
- f. Correspondent-centric management email system uses messagecorrespondent relationship data table for automatically linking a single stored message with its correspondents US 6615241 B1 Miller; Stephen S. et al.
- Method and apparatus for electronic mail interaction with grouped message types
 US 20030167310 A1
 Moody, Paul B. et al.
- Device for reading electronic mails
 US 20020002588 A1
 Sugimoto, Yoshio
- Using fuzzy-neural systems to improve e-mail handling efficiency US 20030187937 A1 Yao, Timothy Hun-Jen et al.

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Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to IMAD HUSSAIN whose telephone number is (571) 270-

3628. The examiner can normally be reached on Monday through Thursday from 0730

to 1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Beatriz Prieto can be reached on 571-272-3902. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/IH/ Imad Hussain

Examiner

/Prieto, Beatriz/ Supervisory Patent Examiner, Art Unit 4117